UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEON A. PINTSOV

Appeal No. 2005-1495
Application 09/703,231

ON BRIEF

Before DIXON, BLANKENSHIP, AND MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-32. Claims 1-23 have been canceled.

We REVERSE.

Invention

Appellant's invention relates to a method for sending an electronic message to the mailer of a mail piece upon delivery of the mail piece. At delivery of the mail piece, the recipient creates a return message and an image of the recipient's signature is captured. These are combined with an image of the mail piece to form an electronic message acknowledging receipt of the mail piece.

Claim 24 is representative of the claimed invention and is reproduced as follows:

> 24. A method for acknowledging the delivery of a mail piece within a mailing system, the method comprising the steps of:
>
> capturing an electronic image of the mail piece;
>
> capturing an image of the recipient's signature when a mail piece is delivered to the recipient;
>
> capturing a response message composed by the recipient when the mail piece is delivered; and
>
> combining the captured electronic image of the mail piece, the captured image of the recipient's signature and the captured response message to form an electronic message response acknowledging receipt of the mail piece.

References

The reference relied on by the Examiner is as follows:

Kara et al. (Kara)	WO 99/21330	April 29, 1999

Rejections At Issue

Claims 24-27 and 29-32 stand rejected under 35 U.S.C. § 102 as being anticipated by Kara.

Claim 28 stands rejected under 35 U.S.C. § 103 as being obvious over Kara.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 24-27 and 29-32 under 35 U.S.C. § 102; and we reverse the Examiner's rejection of claim 28 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims stand or fall together. See page 4 of the brief. We will, thereby, consider Appellant's claims as standing or falling together, and we will treat claim 24 as a representative claim thereof.

I. Whether the Rejections of Claims 24-27 and 29-32 Under 35 U.S.C. § 102 and Claim 28 Under 35 U.S.C. § 103 are proper?

It is our view, after consideration of the record before us, that the disclosure of Kara does not fully meet the invention as recited in claims 24-27 and 29-32, and that the evidence relied

[1] Appellant filed an appeal brief on April 12, 2004. The Examiner mailed an Examiner's Answer on July 14, 2004.

upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 28. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 24, Appellant argues at page 7 of the brief, "[a]lthough Kara discloses that a receipt of actual delivery may include an acknowledgement of delivery by the recipient, there is no disclosure or suggestion that the acknowledgement may be anything other than the signature of the recipient." We agree.

We have reviewed pages 27 and 37 cited by the Examiner to teach the "response message composed by the recipient." While these pages clearly teach a response from the recipient, they do not teach that the response is a "message composed by the recipient." We have also reviewed the remainder of Kara and find nothing that cures this defect in the Examiner's rejection. We note that it might be argued that composing and returning a signed response message when a message is received is an old and well-known method of message receipt acknowledgement, and it might be argued that adding such to Kara is obvious in the extreme. However, no such rejection is before us.

Therefore, we will not sustain the Examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 24-27 and 29-32; and we have not sustained the rejection under 35 U.S.C. § 103 of claim 28.

REVERSED

JOSEPH L. DIXON)
Administrative Patent Judge)
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) BOARD OF PATENT
HOWARD B. BLANKENSHIP) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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